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MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C.			FELTEN, DANIEL S	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/766,277

Filing Date: January 19, 2001

Appellant(s): SAMSON, ROBERT K.

Ido Rabinovitch
(Reg. No. L0080)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/08/2010 appealing from the Office action mailed

3/08/2010

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application: Claims 78-86 and 113-116 are rejected and pending.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN

REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6275814	GIANSANTE et al	8-2001
5126936	CHAMPION et al	9-1989

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 78-86 and 113-116 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giansante (US 6,275,814) in view of Champion et al (US 5,126,936).

Re claim 78: An investment guidance system for providing financial planning assistance, comprising:

--means for receiving a financial goal from a user (see column 5, lines 47-65);

--means for receiving one or more input decisions upon which the probability of achieving said financial goal is dependent, wherein one of the input decisions includes selecting an asset allocation based on investment risk (see column 5, lines 48+);

--means for determining the probability of achieving said financial goal (see fig. 4, column 4, lines 28-61);

--means for receiving an indication that said user has selected a target asset allocation investment plan in order to achieve said financial goal (see column 5, lines 48-65);

--means for receiving a request to rate a plurality of assets within a selected asset Class (see column 6, lines 36+);

--means for providing two or more criteria associated with said assets for said user to evaluate (see column 6, lines 36+);

--means for determining a normalized value for each of said two or more criteria; means for receiving a relative weight of importance for said two or more criteria based on the user's personal investment preferences (see column 6, lines 36+);

--means for determining a rating for each asset based on the normalized values and the relative weights assigned to said two or more criteria (see column 6, lines 36+)

--means for ranking plurality of said assets based on said rating (see column 6, lines 36+)

--Giansante fails to disclose means for receiving a request to execute a trade for one or more of the ranked assets in order to fulfill said target asset allocation investment plan; and means for executing said trade for one or more of the selected ranked assets. This is disclosed by Champion (see fig. 3, column 6, lines 13-33). It would have been obvious for Giansante to be motivated to execute trade requests, as contemplated in Champion, to allow the user to implement the asset suggestions of Giansante and to further allow the user to optimize the level of industry sector and investment style diversification in the portfolio, whereby the portfolio is maintain the portfolio at a position on or near the efficient frontier and at the desired risk level (see Giansante, column 6, lines 36+).

Re claim 79: means for reallocating asset distribution in a user's portfolio based on executed trades. (see reasoning provided in claim 78)

Re **claim 80:** means for receiving additional requests to execute said trade for one of the ranked assets in order to fulfill said target asset allocation investment plan (see reasoning provided in claim 78)

Re **claim 81:** means for evaluating said target asset allocation investment plan against one or more financial goals;

--means for alerting the user if progress towards one or more financial goals deviates substantially (see reasoning provided in claim 78)

Re **claim 82:** wherein said financial goal is a retirement income (see reasoning provided in claim 78)

Re claim 83: wherein one of said input decisions upon which the probability of achieving said financial goal is dependent is a 401 (k) contribution rate (see reasoning provided in claim 78)

Re claim 84: wherein one of said input decisions upon which the probability of achieving said financial goal is dependent is a taxable savings rate (see reasoning provided in claim 78)

Re claim 85: wherein one of said input decisions upon which the probability of achieving said financial goal is dependent is the income required at retirement (see reasoning provided in claim 78)

Re claim 86: wherein one of said input decisions upon which the probability of achieving said financial goal is dependent is an anticipated retirement age (see reasoning provided in claim 78).

Re claim 113: wherein the means for determining the normalized value for each of said two or more criteria comprise: means for creating a distribution of the assets; and means for computing, for each of said two or more criteria of each of the assets in the distribution, normalized values of said two or more criteria based on the relative position of the respective asset in the distribution. (see reasoning provided in claim 78).

Re claim 114: wherein the means for determining the rating for each asset based on the normalized values comprises:

means for multiplying each of the normalized values associated with each of the

assets by the respective relative weight of importance; and

means for summing the normalized values associated with each of the assets

multiplied by the respective weights to obtain the respective rating for each of the assets, the respective rating being an aggregate sum corresponding to the respective asset's associated values multiplied by the associated values' respective weights. (see reasoning provided in claim 78)

Re claim 115: wherein the means for means for ranking plurality of said assets based on said rating comprises:

means for ranking the assets based on the aggregate sum for each of the assets (see reasoning provided in claim 78)

Re claim 116: wherein the two or more criteria comprises one or more of: an R-squared value representative of a correlation between the value of an asset and the behavior of one more benchmark indices, a tax efficiency value computed as an after-tax returns for the asset divided by the pre-tax returns, an information ratio representative of the consistency with which a manager managing the assets generally beats the one or more benchmark indices, a risk factor associated with the asset, administrative fees associated with the asset and standard deviation associated with the asset. (see reasoning provided in claim 78)

(10) Response to Argument

The appellant's main assertion is that Giansante lacks "means for receiving a relative weight of importance for said two or more criteria..." and "means for determining a rating for each asset based on the normalized values and the relative weights..." or "means for ranking" It is respectfully maintained that there is an uncertainty from the applicant's specification as to the corresponding structure to perform the various functions the applicant maintains as not found in the Giasnsante reference. It is being maintained that the 35 U.S.C. 103 set forth on 6/09/2009 provided reasoning for the combination of references and the applicant's piecemeal analysis of the reference can not be used to show non-obviousness by attacking the references individually. Similar to the applicant's invention, it is maintained that Giasnsante, in combination with Champion, discloses adjusting the weights of assets in each efficient portfolio to optimize the level of industry sector and diversification in the portfolio to maintain the portfolio at a position on or near the efficient frontier and the desired risk level. It is being maintained that the adjusting of weights to optimize the level of industry sector suggest a functional equivalent of ranking and normalization claimed in the applicant's invention inasmuch as normalization seeks to reduce redundancies in data to make its use more efficient and the maintenance of the portfolio a certain position and at a certain risk level suggests ranking (see at least Giansante, column 6, lines 7-67).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Daniel S Felten/

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